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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,155	10/01/2001	Ole Sibbesen	078883-0132	9265

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/869,155

Applicant(s)

SIBBESEN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 26.Claim(s) withdrawn from consideration: 1-8, 11, 27-34, 36, 38-39, 41, 44-45.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Manjunath N. Rao, Ph.D.
Primary Examiner
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Claims 1-8, 11, 26-34, 36, 38-39, 41, 44-45 are now currently pending in this application. Claim 26 is now under consideration. Claims 1-8, 11, 27-34, 36, 38-39, 41, 44-45 remain withdrawn from consideration as being drawn to non-elected invention.

Applicant's request for reconsideration filed on 11-5-04 has been considered and ENTERED. However, it does not place the application in condition for an allowance for the following reasons.

In response to the previous Office action, applicants have traversed the obviousness rejection. Applicants basically argue that Examiner has based the rejection on an "obvious to try" standard as well as on improper hindsight and sum up their argument that the Food industry believes that identification of the resistant xylanase as extremely important and innovative and that the references of Rouau et al. and Debseyer et al. fails to teach or suggest the claimed method. Examiner respectfully disagrees.

Applicants argue that contrary to Examiner's assertion --that because the inhibitor is inherently found in the wheat flour the only option available to those skilled in the art was to remove the inhibitor or identify xylanases that are resistant to inhibitor--, there were other methods such as increasing the concentration of the enzyme and those skilled in the art could adjust the amount of inhibitor present as suggested by one of the references. Next, they argue, nowhere in the cited references is it taught or suggested to identify one or more xylanases having high degree of resistance to the xylanase inhibitor using the claimed method. Examiner respectfully disagrees with the above lines of argument. First of all obviousness of the claimed method is not overcome by the fact that there were more methods than suggested by the

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Examiner to overcome the inhibition by the inhibitor. Applicants are taking the exemplifications by the Examiner totally out of context. Second, it is the combination of the teachings of the two references that Examiner asserts as being obvious and not the individual references. Examiner asserts that there is no question of "obvious to try" standard given the facts that were well known in the art.

Applicants next provide a copy of the press release which shows that Danisco received the "most innovative ingredient award" for identifying the uninhibited xylanase to show that the food industry believes the identification of uninhibited xylanases as extremely important development in enzymes over the last 25 years. Examiner acknowledges the press release, however, wonders as to how it can overcome the above rejection. This is because, the press release is about the resistant enzyme and nothing about the claimed method.

Applicants go back to the reference of Rouau et al. and argue that the reference fails to teach or suggest that the inhibitor is isolated. Applicants argue that the reference contains statements casting doubts as to whether the slurry contains one or several inhibitory compounds and whether they are endogenous to the wheat grain or microbial in origin. Applicants argue that since the reference uses the term "assumed" in one of the sentence explaining the source of the inhibitor, it is at odds with the concept of certainty and that the oxford dictionary defines the term as "the act of accepting without proof". Examiner respectfully disagrees with all the above arguments as persuasive to overcome the rejection. First of all applicants appear to be taking out of context the passages in the reference. While Examiner does not disagree that such a statement has been made in the reference, he asserts that applicants arguments are highly misplaced. Regarding the definition of the term "assumed", Examiner draws applicant's attention to other

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definitions in the same dictionary such as “for purpose of argument or action” and “undertake” which can be interpreted in a totally different angle. Furthermore, Examiner would like to drawn the attention of the applicants to more definitive statements in the reference such as “Although no protection of the pentosanase activity was obtained using bovine serum albumin, it remains a possibility that the inhibitor could be one or several wheat proteases that does not recognize this protein” (see page 69, column 2, lines 25-29). The reference clearly teaches that the inhibitor is a wheat protease.

Applicants continue their argument that Debyser et al. also fails to teach or suggest the claimed methods and that the Examiner is basing the rejection on improper hindsight.

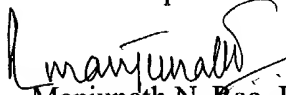
Applicants argue that the presence of inhibitor was not viewed as a barrier in the baking industry and that a controlled level of addition of xylanase enzyme could have a positive effect on dough volume...etc. This argument is contradictory with applicant's earlier arguments. Earlier applicants argued that the isolation of a resistant xylanase was welcomed by the baking industry as extremely important and innovative. Even the press release states that “This revolutionizing enzyme represents one of the most innovative developments in enzymes *over the last 25 years*. It is an uninhibited xylanase, not suffering from the interference of *xylanase inhibitors naturally present in different flours...etc.*”. On the one hand applicants argue that the presence of inhibitor was not a barrier and on the other hand they argue that identifying an enzyme which is resistant to the inhibitor “*naturally present in different flours*” is an extremely important invention.

Irrespective of what applicants argue Examiner takes the position that the problem of xylanase inhibition was well recognized and there was a concerted effort to overcome the same, one of which was to identify resistant enzymes.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case that is what Examiner has actually done, i.e., taken into account the knowledge that a inhibitor of xylanase exists in the wheat flour and other facts discussed in the rejection, which was within the level of ordinary skill in the art at the time the invention was made. Therefore, the above rejection is maintained.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306/9307 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


Manjunath N. Rao, Ph.D.
Primary Examiner
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November 29, 2004